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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/538,359	06/13/2005	Dirk Rottger	273059US0XPCT	5796
22850 7590 02/10/2009 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER CHUNG, SUSANNAH LEE				
ART UNIT 1626		PAPER NUMBER		
NOTIFICATION DATE 02/10/2009		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/538,359

Applicant(s)

ROTTGER ET AL.

Examiner

Susannah Chung

Art Unit

1626

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8 and 11-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8, and 11-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S5108)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Claims 1-6, 8, and 11-14 are pending in the instant application. Claims 7, 9 and 10 are canceled. Claims 13 and 14 are new.

Response to RCE

Receipt is acknowledged of a request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e) and a submission, filed on 11/20/2008. The submission, amendment to the claims and response are responsive to the action mailed on 11/3/2008.

The amendment to the claims and response have been carefully considered, but do not place the claims in condition for allowance at this point in time.

Claims 1-9 were rejected under 35 U.S.C. 112, first paragraph, because **the specification although enabling for a process of making a final product of formula (I) (found in claim 3) reacting a metal of Group 6-10 (subject to the proviso) with a compound of formula (II) or (III) within the scope of formulae (V) to (X) (found in claim 2)** is not enabled for a process of making an undisclosed compound using a metal of Group 6-10 (subject to the proviso) with a compound of formula (II) or (III). Applicants arguments, amendment to the claims and intent are understood, but the claim language is overly broad and can include compounds not intended by Applicant. It is noted that the instant claims use comprising language which could include additional elements not seen in the claim. Without a description of the final product or the enabled intermediates, the process claim fails under the enablement standard. Applicants may overcome this enablement rejection by adding the enabled limitations, i.e. the final product and enabled intermediates (compounds of formula (V) to (X) into claim 1.

Claims 1-9 were rejected for the terms "metal complexes," "reacting," and "complexes of metals of groups 6 to 10 of the Periodic Table of the Elements." This rejection will be overcome if the specific compounds are added into the claims because it will clarify the terms.

Claims 1-9 were rejected under 35 U.S.C. 102(b) and 35 U.S.C. 103(a) as being anticipated by and made obvious over McGuinness, et al (J.A.C.S., Vol. 123, No. 34, 2001). Applicant's arguments and amendments to the claims have been considered and are found persuasive for claims 1-6, 8 and 11-13, but are not found persuasive for claim 14. Claim 14 still reads on McGuinness because the compound of formula (VI) can tautomerize into the imidazolium compound of McGuinness (see previous office actions mailed on 4/24/08, 8/20/08 and 11/3/08).

Claims 1-6, 8 and 10-12 were rejected under 35 U.S.C. 112, first and second paragraph, as new matter. This rejection is withdrawn in view of the support specifically disclosed in the response filed on 11/20/2008.

Claims 10-12 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 10 is canceled and the rejection is overcome. The rejection of Claims 11 and 12 are maintained because the terms "olefinic material," "nucleophile," and "the reaction product of Claim 1" are indefinite. First, the term "reaction product" lacks antecedent basis. There is no reaction product in Claim 1. The reaction product should be defined or the claim made dependent on the claims with the reaction product. Second, the terms olefinic material and nucleophile are broad and the metes and bounds of the claim are unknown. The definitions found in claim 12 should be imported into claim 11. Appropriate correction is

required. In addition, new claim 13 is also rejected under 112, 2nd paragraph for being indefinite. The terms “a metal complex (I)” and “as prepared by the method of Claim 1” are indefinite. The term “metal complex (I)” is not defined. Is claim 13 dependent on claim 1? It is unclear whether the claim is dependent on claim 1 or if the process of making the compound of formula (II) and (III) are being incorporated into claim 13. If the process of making the compound of formula (II) and (III) are being claimed then there is a lack of antecedent basis because claim 1 does not discuss the process of making a compound of formula (II) or (III). Appropriate correction is required. Should Applicants require assistance in amending the claims please contact the Examiner below.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susannah Chung whose telephone number is (571) 272-6098. The examiner can normally be reached on M-F, 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 10/538,359
Art Unit: 1626

Page 5

/Golam M. M. Shameem/
Primary Examiner, Art Unit 1626

Susannah Chung, 2/3/2009